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Atty. Dkt. No. MRKS/0122

NOV 17 2006

## REMARKS

This is intended as a full and complete response to the Office Action dated August 23, 2006, having a shortened statutory period for response set to expire on November 23, 2006. Please reconsider the claims pending in the application for reasons discussed below.

***Interview Summary***

On November 17, 2006, a telephone interview was conducted with the Examiner, Examiner Lowell Larson, and Chance Hardie. Claim 1 was discussed in view of the rejections in the office action. A potential agreement was reached that *Metcalfe et al.* (U.S. Patent No 6,527,049) fails to disclose the method as claimed for at least the reasons set forth herein.

***Claim Rejections - 35 U.S.C. § 112***

Claims 14, 15, 21 and 22 stand rejected under 35 U.S.C. § 112, second paragraph.

Applicants amended claims 14 and 15 to clarify any ambiguity and provide relationship context for the terms "circumferentially spaced" and "axially spaced." Regarding claims 21 and 22, expansion with a "cone swage expander" represents a term that is not relative. As understood by one skilled in the art, this common known method of expansion involves forcing a cone shaped member with a larger outer diameter than the tubing's inner diameter through the tubing. Therefore, claims 14, 15, 21 and 22 particularly point out and distinctly claim the subject matter encompassed by the terms recited therein. Accordingly, Applicants respectfully request withdrawal of the rejection and allowance of the claims.

***Claim Rejections - 35 U.S.C. § 102***

Claims 1-29 stand rejected under 35 U.S.C. § 102(b) as being anticipated by *Metcalfe et al.* (U.S. Patent No 6,527,049). In response, Applicants respectfully traverse the rejection.

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Claim 1 recites a method of increasing collapse resistance of a tubular that includes the act of "selecting a level of the radial force to increase collapse resistance of the tubular." However, *Metcalfe et al.* is silent with respect to collapse resistance much less any act of selecting a radial force level such that collapse resistance increases. As an overview, the yield and tensile strength tend to increase as a function of expansion ratio and material properties with expansion techniques such as described in *Metcalfe et al.* Collapse resistance, however, nevertheless tends to decrease due to the decrease in tubular wall thickness and increase in tubular diameter caused by the expansion. Consequently, the method disclosed *Metcalfe et al.* does not inherently increase collapse resistance and lacks any indication of performing any particular act chosen to achieve such a result.

The Examiner further states that "statements of intended use or field of use... clauses are essentially method limitations" and that "statements of intended use do not serve to patentably distinguish the claimed structure over that of the reference." However, all the pending claims are directed to methods and not a structure or apparatus as recited in MPEP §§ 2114 and 2115, which are also cited by the Examiner. For clarity, Applicants nevertheless amended claims containing such statements to recite acts of the methods in a more affirmative manner.

Therefore, *Metcalfe et al.* fails to teach, show or suggest a method of increasing collapse resistance as claimed. Since each and every element of claim 1 is not disclosed in *Metcalfe et al.*, the reference cannot anticipate the claim or any claim dependent thereon. Accordingly, Applicants submit that claims 1-29 are allowable and respectfully request allowance thereof.

#### ***New Claims***

Based on the traversal of record, Applicants submit that the cited prior art fails to teach, show or suggest each and every element of the new claims. With respect to claims 54-55, *Metcalfe et al.* also fails to disclose that "the tubular experiences substantially no diametric expansion as a result of the radial force applied by the bearing member" since the method taught therein increases a diameter of expandable tubing. Regarding claim 56, *Metcalfe et al.* further lacks any reference to "expanding

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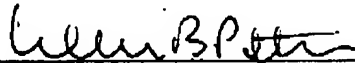
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the tubular with a cone expander" prior to "locating a tool having at least one bearing member within the tubular" and "placing the bearing member in engagement with a wall of the tubular to apply a radial force to first and second separated discrete zones of the wall." The new claims contain no new matter. Accordingly, Applicants submit that the new claims are allowable and request allowance thereof.

### ***Conclusion***

Having addressed all issues set out in the office action, Applicants respectfully submit that the claims are in condition for allowance and respectfully request that the claims be allowed.

Respectfully submitted,



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